

APPLICANT(S): E. Amitay
SERIAL NO.: 10/743,158
FILED: December 22, 2003
Page 4

REMARKS

The present response is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

Applicant asserts that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

Status of Claims

Claims 1 – 55 are pending in the application. Claims 1 – 55 have been rejected.

In this Amendment, Applicant has cancelled claims 1 – 36 and 46 – 55 from further consideration in this application. Applicant is not conceding that the subject matter encompassed by claims 1 – 36 and 46 – 55, prior to this Amendment is not patentable over the art cited by the Examiner. Claims 1 – 36 and 46 – 55 were cancelled in this Amendment solely to facilitate expeditious prosecution of the subject matter of claims 37 – 45. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by claims 1 – 36 and 46 – 55, as presented prior to this Amendment and additional claims in one or more continuing applications.

New claims 56 – 63 have been added in order to further define what the Applicant considers to be the invention. Applicant respectfully asserts that no new matter has been added.

The Telephone Interview

Initially, Applicants wish to thank the Examiner, Michael Pham, and the Supervisory Primary Examiner, Camy Truong, for granting and attending the telephone interview, with Applicant's Representative, Heidi M. Brun, Reg. No. 34,504 on July 29, 2008. In the interview, claims 37 – 45 and new claim 56 were discussed, as was the Prokoph citation.

APPLICANT(S): E. Amitay
SERIAL NO.: 10/743,158
FILED: December 22, 2003
Page 5

CLAIM REJECTIONS

35 U.S.C. § 101 Rejections

In the Office Action, the Examiner rejected claims 1 – 36 and 46 – 55 under 35 U.S.C. § 101, as directed to non-statutory subject matter.

Claims 1 – 36 and 46 – 55 have been voluntarily cancelled and accordingly their rejection is now moot.

35 U.S.C. § 102 Rejections

In the Office Action, the Examiner rejected claims 1, 10 – 11, 13 – 14, 22 – 24, 27, 29, 37, and 46 under 35 U.S.C. § 102(b), as being anticipated by Prokoph (US Patent Application Publication 2002/0091671). Applicant respectfully traverses this rejection in view of the remarks that follow.

Claims 1, 10 – 11, 13 – 14, 22 – 24, 27, 29, and 46 have been voluntarily cancelled and accordingly their rejection is now moot.

Claim 37 of the present application recites: “adding information from at least some of said user queries to said index.”

In contrast, Prokoph teaches a method for generating and accessing a document search index based on reduced versions of the indexed documents, i.e. “document extracts” (Paragraph 0022). Not only does Prokoph not disclose a method for “adding information from user queries” but he specifically teaches away from it. Prokoph teaches refining the search index by screening out “references to inconsequential portions of a document” (Paragraph 31). Performance and accuracy is thus to be improved by reducing the size and contents of a document index (Paragraph 23). Accordingly, the teachings of Prokoph specifically preclude adding information from user queries, as that would enlarge the index and Prokoph teaches reducing its size.

In the Office Action, the Examiner cited Figure 2 of Prokoph as “enhancing (206, adds more indexes) an index (207) with at least some user queries (212, 200, 208, allows the client to issue search queries).” Applicant respectfully disagrees.

APPLICANT(S): E. Amitay
SERIAL NO.: 10/743,158
FILED: December 22, 2003
Page 6

As detailed in the specification (Paragraph 0034), regarding Figure 2, Prokoph teaches coupling search service 200 to “indexer 206 which allows the client 201 to issue search queries 212 against the search index 207.” The relationship between search index 207 and search queries 212 is typical: search queries 207 use search index 207 to search for documents. Figure 2 does not show "adding information from user queries ... to said index" but rather, it shows extracting information (with extractor 209) from the documents being indexed. Prokoph therefore cannot provide “adding information from at least some of said user queries to said index.”

In the interest of moving prosecution forward, new independent claim 56 will also be discussed.

Prokoph does not teach nor suggest "associating terms in user queries with documents said terms were used to retrieve and adding said terms to an index with which said documents were retrieved" as recited in new claim 56. As discussed hereinabove, Prokoph teaches improving performance and accuracy by reducing the size and contents of a document index. Accordingly, Prokoph teaches away from adding said terms to an index with which said documents were retrieved.

35 U.S.C. § 103 Rejections

In the Office Action, the Examiner rejected claims 2 – 9, 12, 15 – 21, 25 – 26, 28, 30 - 36, 38 – 45, and 47 – 55 under 35 U.S.C. § 103(a), as being unpatentable over Prokoph in various combinations together with Dessloch et al (U.S. Patent 6338056), Bowman et al (U.S. Patent 6169986), Gharachorloo et al (U.S. Patent 7254580), and Brown et al (U.S. Patent Application Publication 2003/0149687). Applicant respectfully traverses these rejections in view of the remarks that follow.

Claims 2 – 9, 12, 15 – 21, 25 – 26, 28, 30 - 36, and 47 – 55 have been voluntarily cancelled and accordingly their rejection is now moot.

Regarding claims 38 – 45, as discussed hereinabove, Prokoph cannot provide “adding information from user queries” as recited in claim 37. Dessloch et al, Bowman et al, Gharachorloo et al, and Brown et al are similarly silent regarding “adding information from

APPLICANT(S): E. Amitay
SERIAL NO.: 10/743,158
FILED: December 22, 2003
Page 7

user queries". Accordingly, combining Prokoph with any or all of Dessloch et al, Bowman et al, Gharachorloo et al, and Brown et al cannot provide all the limitations of claim 37. As claims 38 – 45 depend from, directly or indirectly, claim 37, they therefore include all the limitations of that claims.

In the interest of moving prosecution forward, claims 57 – 63 will also be discussed.

As discussed hereinabove, Prokoph cannot provide "associating terms in user queries with documents said terms were used to retrieve" or "adding said terms to an index with which said documents were retrieved" as recited in new claim 56. As discussed hereinabove, Prokoph teaches improving performance and accuracy by reducing the size and contents of a document index. Accordingly, Prokoph teaches away from "adding said terms to an index with which said documents were retrieved".

Accordingly, Applicant asserts that neither Prokoph nor Prokoph in combination with any of Dessloch et al, Bowman et al, Gharachorloo et al, and/or Brown et al teach or suggest the limitations of claim 37, nor of new independent claim 56. Accordingly, Applicant respectfully asserts that independent claims 37 and 56 are allowable. Claims 38 – 45 and 57 – 63 depend from, directly or indirectly, claims 37 and 56 and therefore include all the limitations of those claims. Therefore, Applicant respectfully asserts that claims 38 – 45 and 57 – 63 are likewise allowable. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejections to claims 38 – 45 and allow claims 38 – 45 and 57 – 63.

Petition For Two-Month Extension Of Time Under 37 CFR 1.136(a)

The period for responding to the instant Notice was set to expire on July 1st, 2008. Applicant hereby requests that the period for responding to the instant Office Action be extended by two (2) months, so as to expire on September 1st, 2008. Accordingly, this response is being timely filed.

The fee for a Petition for a Two-Month Extension of Time is Four Hundred and Sixty Dollars (\$460.00) for a large entity, for which electronic payment is provided herewith. However, The United States Patent and Trademark Office is hereby authorized to charge

APPLICANT(S): E. Amitay
SERIAL NO.: 10/743,158
FILED: December 22, 2003
Page 8

Deposit Account No. 090468 in the amount of \$460 and any additional fee which is necessary in connection with the filing of this amendment and petition.

In view of the foregoing amendments and remarks, the ending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this response to Deposit Account 09-0468.

Respectfully submitted,

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